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| 09/647,054 | | Peter Joseph Cassidy | 080056-00020 | 3789 |

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10/07/2003

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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 10/07/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
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| 09/647,054 | 02/06/2001 | CASSIDY | 080056-000200US |

| EXAMINER | |
|----------------------------|--------------|
| Maurie Garcia Baker, Ph.D. | |
| ART UNIT | PAPER NUMBER |
| 1639 | 15 |

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application

Commissioner of Patents

Please see attached Notice of Non-Responsive Amendment.

DETAILED ACTION***Notice of Non-Responsive Amendment***

1. The Response filed July 21, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

In the Response filed July 21, 2003, Applicant elected claims 74-90 for examination with traverse. However, the Restriction Requirement mailed February 21, 2003 specifically stated that if "claims 74-90 are elected, election of a single invention from within this group of claims is required as specifically set forth" (see paragraph 3 of that action). The examiner specifically stated that claims 74-90 contain a large number of independent and distinct inventions and that a single invention that is encompassed by these claims should be elected. See page 7 of the Restriction Requirement, the relevant portion is reproduced below:

Groups LXXI., etc.: Claims 74-90, drawn to a "general mimetic" of structure X. These claims contain a large number of independent and distinct inventions. If this group is selected than election of a single invention where the following groups are defined is required:

Q¹, Q², Q³ and Q⁴ (and Q⁵ if present) must all be specifically defined

This means that each of the Q groups must be specifically set forth where the specific structure (cyclic, non-cyclic) is shown and all variable groups are defined therein. This should result in a single defined cyclic core structure showing all rings therein which is further functionalized by the R and M groups.

Applicant has instead treated this requirement for restriction as an election of species and sets forth a "provisional election" and states that if art is not found on the elected species that the examiner should continue the search (Response,

page 7). Again, the examiner reiterates that the above noted requirement is a restriction between independent and distinct inventions and not an election of species. The different compounds encompassed by the claims differ in respect to their structure (ring size and composition), their properties, their use and the synthetic methodology for making them. Therefore, they have different issues regarding patentability and enablement and represent patentably distinct subject matter, which merits separate and burdensome searches.

As stated in the previous action, there is not a single inventive concept that links all of the claims. The compounds encompassed by the instant formulas do not all possess a common structure (no shared significant structural element) and each of the different structures would represent a different inventive concept. Applicant argues that since the claim is set forth in Markush format, it has unity. Note 37 CFR § 1.475 *Unity of invention before the International Searching Authority, the International Preliminary Examining Authority and during the national stage*: Section (e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Applicant has amended the claims and replaced claims 74-90 with new claims 113-133 (which have been renumbered, see paragraph 3 below). These claims suffer from the same problems as original claims 74-90 and thus are

deemed to represent a myriad of different inventions. Applicant is required to elect a single invention as set forth previously and reiterated above.

Note that the traversal and request for rejoinder of some groups with the elected group will be fully addressed when the case is examined on the merits (following a fully responsive election).

2. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).


3. **ALSO NOTE:** The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Misnumbered claims 113-133 have been renumbered as 109-129.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is

(703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306- 3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
October 3, 2003



MAURIE GARCIA BAKER, PH.D.
PRIMARY EXAMINER